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09/422,758	10/21/1999	CHARLES C. PACKHAM	11223/002001	5962

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EXAMINER

GOODMAN, CHARLES

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/422,758

**Applicant(s)**

PACKHAM ET AL.

**Examiner**

Charles Goodman

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 38-58 is/are pending in the application.
- 4a) Of the above claim(s) 20,21,40,41,44,45,48 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,38,39,42,43,46 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12/10/02 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The Amendment filed on December 10, 2002 has been entered.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on December 10, 2002 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the features in the proposed amendment to Fig. 3. It is noted that with respect to the other proposed drawing corrections, these will be given favorable consideration if submitted separately.

### ***Election/Restrictions***

3. Claims 20, 21, 40, 41, 44, 45, 48, and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Groups and Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "118" has been used to designate both a parabolic end skirt (Fig. 1) and an under cutter (Fig. 11); "243" has been used to designate both a cutaway of a mask (Fig. 26) and a foil aperture pattern (Fig. 27); "41" has been used to designate both a curved under cutter (Fig. 4) and a developer (Fig. 32); "42" has been used to designate by a drive arrangement (Fig. 4) and something that appears to be a stirrer (Fig. 32). A

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proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because in Fig. 18, reference "61" should read -- 161 --. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elongate hair-capture slots (e.g. claim 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "121"; "181"; "244"; "341". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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9. Claims 1-17, 50-54, 57, and 58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pranjko (DE M9004739.7). See Fig. 1.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 18, 19, 38, 39, 42, 43, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7) in view of Packham (GB 2,036,631 A).

Pranjko discloses the invention substantially as claimed. Although Pranjko does not show an under cutter *per se*, it is the Examiner's position that Pranjko's depicted device would inherently include an under cutter that is oscillatory driven by a driving element due to the fact that the shaving system of Pranjko is a dry shaver with a curved skin engaging surface wherein during operation of the device, a cooperating under cutter is necessary to facilitate the shave. See whole document. However, if it is argued

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that Pranjko lacks the under cutter and drive element, then Packham clearly teaches a shaving system comprising a curved outer surface 8 which functions as an outer cutter, an under cutter 9 conforming to the outer cutter, and a drive element 4 that oscillates the under cutter for the purpose of providing the positive cutting action for drive shaver systems. See Fig. 2, p. 1, ll. 93-125. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the under cutter and drive element as taught by Packham in order to facilitate positive cutting action of the dry shaver.

13. Claims 18, 19, 38, 39, 42, 43, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7) in view of Furuichi (JP 405049760).

Pranjko discloses the invention substantially as claimed. Although Pranjko does not show an under cutter *per se*, it is the Examiner's position that Pranjko's depicted device would inherently include an under cutter that is oscillatory driven by a driving element due to the fact that the shaving system of Pranjko is a dry shaver with a curved skin engaging surface wherein during operation of the device, a cooperating under cutter is necessary to facilitate the shave. See whole document. In that regard, Furuichi clearly teaches a shaving system comprising a curved outer surface 2 which functions as an outer cutter, an under cutter 3 conforming to the outer cutter, and a drive element e.g. 4 that oscillates the under cutter for the purpose of providing the positive cutting action for drive shaver systems. See whole document. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the under cutter and drive element that conforms to the shape of the outer cutter as taught and suggested by Furuichi in order to facilitate positive cutting action of

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the dry shaver, and since with respect to the conforming shape, such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art, especially since such a change does not render unexpected or unobvious results. *In re Rose*, 105 USPQ 237 (CCPA 1955).

14. Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7).

Pranjko discloses the invention substantially as claimed including what appears to be same material curved regions and end cheek regions. However, if it is argued that Pranjko lacks this feature, then it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the same material regions in order to facilitate ease of manufacture due to the same material being used to produce the same, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Double Patenting***

15. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope.

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The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

16. Claims 1-7, 10-13, 16, 17, 50-54, 57, and 58 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. Des. 428,671.

This is a double patenting rejection.

### ***Response to Arguments***

17. Applicant's arguments filed December 10, 2002 have been fully considered but they are not persuasive.

Initially, it is noted that Applicant's arguments are basically the same as presented in the prior amendment. Thus, the Examiner's comments in the last Office Action equally applies. The following will address some of the more pertinent issues raised by the Applicant.

18. In response to Applicant's basic argument that Pranjko does not anticipate the claimed invention because of the lack of written description,<sup>1</sup> this argument lacks merit. First, claims 1, 16, and 17, inter alia, claim a shape of a shaving cutter. "Shape" by definition is a design. In that regard, the *design* (shape) of Pranjko clearly anticipates the claims whether ornamental or not. Second, it is again emphasized that a written description or enablement is not required in this case with respect to the claims and Pranjko. None of the anticipated claims include any working or moving parts. The anticipated claims encompass the outward shape or appearance of a shaving cutter. Why is it necessary for the prior art reference to include an "enabling" disclosure for the

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<sup>1</sup> Amendment E, Paper No. 24, pp. 5-13.



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shape? On the other hand, it is not clear to the Examiner why the drawings in Pranjko do not meet the “enablement” requirement as Applicant argues. The claims require a shape, and Pranjko clearly shows the claimed shape which is enabled by the drawing depictions. Third, Applicant is basically couching majority of the arguments on improper hindsight reasoning. This argument does not apply to anticipation. Even if it did, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). This applies to all of Applicant's assertions of hindsight. Fourth, Applicant's arguments with respect to claims 5, 6, and 10 are couched in the assertion that the “cutter” must be limited to the central cutter. However, the claims do not require such a consideration so none is made.

In response to Applicant's basic argument that there is no double patenting,<sup>2</sup> this argument is traversed. As emphasized *supra*, the rejected claims claim a shape which the design patents clearly show. In the alternative, even if a two-way test need to be shown, the ornamental design of Packham et al '671 clearly includes the shape, i.e. limitations, of the rejected claims, and the rejected claims clearly read on the different regions of the cutter shown in Figs. 1-7 of Packham et al '671.

***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.


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<sup>2</sup> Id., pp. 16-19.

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In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

  
**Charles Goodman**  
**Primary Examiner**  
**AU 3724**

cg   
February 24, 2003

**CHARLES GOODMAN**  
**PRIMARY EXAMINER**